

## REMARKS

Claims 107 and 116-121 are canceled and claim 133 is newly added. Claims 105, 106, 108-115, and 122-133 are now pending in the present application. Applicants respectfully traverse all of the rejections of the Office Action. Reconsideration and allowance of the application and presently pending claims 105, 106, 108-115, and 122-133 are respectfully requested. Applicants should not be presumed to agree with any statements made by the Examiner in the Office Action unless otherwise specifically indicated by the Applicants.

### I. Interview Summary

Applicants first wish to express their sincere appreciation for the time that Examiner Bui spent with Applicants' representatives, Minh Nguyen and Arturo Rodriguez, during a telephone discussion on November 4, 2004, regarding the outstanding Office Action. Applicants believe that certain important issues were identified during the telephone discussion, and that they are resolved herein. During that conversation, the Examiner seemed to indicate that it would be potentially beneficial for Applicants to make the amendments herein, particularly the feature of a viewer's preference for outputting advertisement that corresponds to a selected advertisement category. Thus, Applicants respectfully request that Examiner Bui carefully consider this response and the amendments.

### II. Response to Claim Objection and Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

In the Office Action, claim 107 is rejected under 35 U.S.C. 112, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have canceled claim 107 to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public. Claims 107 is canceled without prejudice, waiver, or disclaimer. Applicants should not be presumed to agree with any statements made by the Examiner in the

Office Action regarding the rejection of claim 107 under 35 U.S.C. 112 unless otherwise specifically indicated by the Applicants.

III. Election/Restrictions for Claims 116-121

In the Office Action, claims 116-121 were withdrawn from consideration as being directed to a non-elected invention. Applicants have canceled claims 116-121 to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public. Claims 116-121 are canceled without prejudice, waiver, or disclaimer. Applicants should not be presumed to agree with any statements made by the Examiner in the Office Action regarding claims 116-121 unless otherwise specifically indicated by the Applicants.

IV. Response to Claim Rejections under 35 U.S.C. §102

Claims 105-115, and 122-132 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Pub. No. US2003/0101454A1 to *Ozer, et al.* Applicants respectfully traverse this rejection.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

A. Claim 105

Claim 105, as amended, recites:

105. A method implemented by a television set-top terminal (STT) configured to provide television programs and a viewer's preference for advertisement categories, the method comprising:

*configuring a memory in the STT to store the viewer's preference for advertisement categories;*

receiving by a tuner in the STT at least one television program;

outputting to a television by the STT the at least one television program;

*providing a first-selectable option for the viewer's preference for advertisement categories;*

outputting to a television by the STT a graphical user interface (GUI) that comprises a plurality of viewer selectable advertisement categories, said plurality of viewer selectable advertisement categories including a first advertisement category and a second advertisement category that is different from the first advertisement category;

receiving by the STT a first viewer input corresponding to the first advertisement category and a second viewer input corresponding to the second advertisement category;

*responsive to receiving the first and second viewer inputs, storing the first and second advertisement categories in the memory of the STT configured to store the viewer's preference for advertisement categories;*

*outputting to the television by the STT an advertisement based on the viewer's preference for advertisement categories, wherein the advertisement is output by the STT at a future time during an interruption in the presentation of the at least one television program being output by the STT.*

(Emphasis Added)

As an initial matter, *Ozer* does not teach or disclose a viewer's preference having at least one selected advertisement category that enables the viewer to view advertisements that correspond to an advertisement category selected by the viewer.

Apparently, *Ozer* discloses in its Abstract as follows:

“A system, including a planning module, a control module and a receiver module, configured to schedule display of advertisements to achieve an advertising impression goal. The planning module enables scheduling of advertising impressions in accordance with target criteria. Further, the planning module enables selecting an advertising impression goal for advertisements, assigning an advertising type and defining a weight for the advertisement. The control module receives the schedule, the advertising type and the defined weights and generates one or more metadata files that contain target criteria, advertising type and weights for the advertisement. *The one or more metadata files and advertising content for the advertisement, are delivered to the receiver module that is configured to define a display frequency for the advertising content based upon one or more of the metadata files. The receiver module selectively displays the advertising content of the advertisement to achieve the advertising impression goal.*”

(Emphasis Added)

Applicants respectfully submit that the *Ozer* receiver module does not allow the viewer to select an advertisement category to be included in a viewer's preference. The *Ozer* receiver

module does not output advertisements based on the list of selected categories in the viewer's preference. Instead, the *Ozer* receiver module receives metadata files from the *Ozer* control module to selectively display the advertising content of the advertisement. The metadata files are defined in Paragraph 20 on page 2 of *Ozer* as:

"in a structured format, the time when the advertisement is to be displayed, the weight or display frequency of the advertisement, the duration of display of the advertisement, time-zone shifts to the display data, the advertisement content associated with the advertisement, and additional targeting information. Further, the metadata files include the type of advertisement where the advertising type indicates whether the advertisement is a committed advertisement or a flexible advertisement."

*Ozer* further discloses in Paragraphs 22 and 23 on page 2-3 of *Ozer* as follows:

"Upon receipt of the advertisement content and the metadata, the receiver module deletes stored advertisement content and/or metadata files and substitutes the newly received advertising content and metadata files for the advertisement.

Subsequently, the receiver module displays the advertisement when needed by selectively displaying the advertisement's associated content based upon the target criteria, these absolute and relative weights, and whether the advertisement is committed or flexible advertisement. Consequently, the planning module, the control module, and the receiver module can schedule and subsequently display advertisements, and more specifically the advertisement content associated with the advertisement, to a viewer, while the modules are intermittently connected one with another."

In short, *Ozer* apparently discloses that the *Ozer* receiver module receives metadata from the *Ozer* control module that is located at a remote location and uses the metadata to selectively display the advertising content for the advertisement to a viewer. Accordingly, Applicants respectfully submit that *Ozer* fails teach or disclose a viewer's preference having at least one selected advertisement category that enables the viewer to view advertisements that correspond to an advertisement category selected by the viewer. More particularly, *Ozer* fails to teach or disclose the following steps recited in claim 105:

"configuring a memory in the STT to store the viewer's preference for advertisement categories; ... providing a first-selectable option for the viewer's preference for advertisement categories; ... responsive to receiving the first and second viewer inputs, storing the first and second advertisement categories in the memory of the STT configured to store the

viewer's preference for advertisement categories; outputting to the television by the STT an advertisement based on the viewer's preference for advertisement categories, wherein the advertisement is output by the STT at a future time during an interruption in the presentation of the at least one television program being output by the STT."

Thus, a *prima facie* case of anticipation cannot be established. Applicants respectfully request that claim 105 be allowed and the rejection be withdrawn.

B. Claims 106 and 108-115

Dependent claims 106 and 108-115 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 105. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

C. Claim 122

Claim 122, as amended, recites:

A method implemented by a television set-top terminal (STT), comprising:

configuring the STT to receive a first plurality of advertisement data components corresponding to respective advertisements, each advertisement being corresponding to a respective advertisement category in a first plurality of advertisement categories;

outputting to a television by the STT a graphical user interface (GUI) that comprises a plurality of selectable advertisement categories, wherein the first plurality of advertisement categories include the plurality of selectable advertisement categories;

receiving by the STT a plurality of viewer inputs respectively corresponding to viewer-selected advertisement categories from the plurality of selectable advertisement categories, wherein the viewer inputs are provided by a viewer of the television;

***responsive to receiving the plurality of viewer inputs, storing in a memory of the STT the viewer-selected advertisement categories; and***

***after receiving the plurality of viewer inputs, receiving by the STT advertisement data components corresponding exclusively to respective advertisements corresponding to the viewer selected advertisement categories.***

(Emphasis Added)

As mentioned above with reference to claim 105, *Ozer* apparently discloses that the *Ozer* receiver module receives metadata from the *Ozer* control module that is located at a remote location and uses the metadata to selectively display the advertising content for the advertisement to a viewer. Accordingly, Applicants respectfully submit that *Ozer* fails teach or disclose viewer-

selected advertisement categories having at least one selectable advertisement category that enables the viewer to view advertisements that correspond to an advertisement category selected by the viewer. More particularly, *Ozer* fails to teach or disclose “responsive to receiving the plurality of viewer inputs, storing in a memory of the STT the viewer-selected advertisement categories; and after receiving the plurality of viewer inputs, receiving by the STT advertisement data components corresponding exclusively to respective advertisements corresponding to the viewer selected advertisement categories,” as recited in claim 122. Thus, a *prima facie* case of anticipation cannot be established. Applicants respectfully request that claim 122 be allowed and the rejection be withdrawn.

D. Claims 123-127

Dependent claims 123-127 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 122. *Supra. In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600.

E. Claim 128

Claim 128, as amended, recites:

A method implemented by a television set-top terminal (STT), comprising:  
outputting to a television by the STT a graphical user interface (GUI) that  
comprises a plurality of viewer-selectable advertisement categories;

***receiving by the STT a plurality of viewer inputs respectively  
corresponding to viewer-selected advertisement categories from the plurality of  
selectable advertisement categories, wherein the user inputs are provided by a  
viewer of the television; and***

***responsive to receiving the plurality of user inputs, outputting to the  
television by the STT a plurality of advertisements respectively corresponding to  
at least one of the viewer-selected advertisement categories.***

(Emphasis Added)

As mentioned above with reference to claim 105, *Ozer* apparently discloses that the *Ozer* receiver module receives metadata from the *Ozer* control module that is located at a remote location and uses the metadata to selectively display the advertising content for the advertisement to a viewer. Accordingly, Applicants respectfully submit that *Ozer* fails teach or disclose viewer-selected advertisement categories having at least one selectable advertisement category that enables the viewer to view advertisements that correspond to an advertisement category selected by the viewer. More particularly, *Ozer* fails to teach or disclose “receiving by the STT a plurality

of viewer inputs respectively corresponding to viewer-selected advertisement categories from the plurality of selectable advertisement categories, wherein the user inputs are provided by a viewer of the television; and responsive to receiving the plurality of user inputs, outputting to the television by the STT a plurality of advertisements respectively corresponding to at least one of the viewer-selected advertisement categories,” as recited in claim 128. Thus, a *prima facie* case of anticipation cannot be established. Applicants respectfully request that claim 128 be allowed and the rejection be withdrawn.

F. Claims 129-132

Dependent claims 129-132 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 128. *Supra. In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600.

V. Newly Added Claim 133

Claim 133 has been newly added to further define and/or clarify the scope of the invention. It is believed that claim 133 should be allowed for at least the reason that the claim depends from allowable independent claim 128. *Supra. In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600.

### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 105, 106, 108-115, and 122-133 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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